

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Hesheng Zhang
US Serial No.:
10/595,609
371(c) date:
04/30/2006
Confirmation No. 3461
For: NOVEL SYNTHESIS OF
DONEPEZIL AND
DERIVATIVES THEREOF

Atty Docket No. TJCZ-00101-NUS
Art Unit: 1625
Examiner: CHANG, CELIA C
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/Sophie Chen/

SOPHIE CHEN

REPLY TO ELECTION REQUIREMENT

SIR:

In the Office Action of March 16, 2009, which did not address the merits of the above-identified patent application, Applicants were required to elect under 35 USC §§ 121 and 372 a single disclosed process for making an elected species (as identified by R₁-R₅ and n) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Specifically, the Examiner alleges that “the species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species.” In addition, the Examiner alleges that “these species are not obvious variants of each other based on the current record.”

Applicant respectfully traverses the requirement for reasons stated below.

Applicant respectfully submits that the species grouped by the Examiner by R_1 - R_5 and n are necessarily related because R_1 - R_5 are substituents in the compound made by the claimed process and n represents chain length of a linker in that compound.

Where there is a relationship between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety thereof. (See, MPEP 808.01(a)) Because the disclosed relation has not been discussed by the Examiner and reasons leading to the conclusion that the disclosed relation does not prevent restriction have not been advanced, the Examiner should withdraw the requirement for election of species.

In addition, in order to establish reasons for insisting upon election, the Examiner must clearly explain why there would be a serious burden on the Examiner if restriction were not required. Although the Examiner has made a cursory assertion that the species require a different field of search; and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph, it is not obvious which one of the assertions from the list actually applies in this case as the assertions are joined by both a conjunctive and a disjunctive. Accordingly, a clear explanation has not been provided. In contrast, Applicant submits that all disclosed species are easily searched using substructure searching by setting R_1 - R_5 and n equal to wildcards.

Accordingly, Applicants respectfully submits that all species may be searched and examined together without placing a significant additional burden on the Examiner. Per MPEP §803, because the search and examination of all the claims in this Application can be made without serious burden, the Examiner must examine them on the merits, even though they are alleged to include claims to independent and distinct inventions. Therefore, Applicants respectfully traverses the Election Requirement, and requests reconsideration, rejoinder of all species, and withdrawal of the Election Requirement.

Status as National Stage Application under 35 USC 371

This application is a national stage application filed under 35 USC 371. Accordingly, unity of invention under 1.475 rather than restriction practice under 1.141-1.146 should govern restriction in this Application. Specifically, because the processes claimed share a special technical feature as defined in steps (a) – (c) of claim 1 and relate to a single inventive concept under PCT Rule 13.1, unity of invention is present and election of species should not be required.

Generic Claims

The Examiner has indicated that claims 1-6 and 11-22 are generic.

Provisional Election

Although Applicant believes that election is improper, as required by 37 CFR 1.143, Applicant hereby provisionally elects with traverse and for examination purposes only a single disclosed process for making a Donepezil derivative of formula (I), wherein R₁ represents hydrogen, R₂ represents methoxy, R₃ represents methoxy, R₄ represents hydrogen, R₅ represents phenyl, and n is 0. Applicant states that claims 1-6 and 11-22 encompass the elected species.

Rejoinder

Applicant reminds the Examiner that where generic claims are allowable, Applicant may claim in the same application additional species as provided by 37 CFR 1.146. Thus, the propriety of the election requirement (if not withdrawn earlier) should be reconsidered when any of the claims directed to the elected species are in condition for allowance. At that time, the Applicant would be entitled to rejoinder of the nonelected species.

Customer Number: **33794**

Respectfully Submitted,

/Matthias Scholl/

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